

### **REMARKS**

By the present amendment claims 3, 5, 9 and 13 have been canceled without prejudice or disclaimer of the subject matter thereof. Independent claim 1 has been amended to incorporate some features of canceled claims 3 and 5 to clarify features of the present invention. Claims 7, 8 and 10 have been amended to clarify features of the present invention.

#### **Rejections under 35 U.S.C. 101**

Claims 8 and 9 stand rejected under 35 U.S.C. 101 as being unpatentable because the claimed invention is directed allegedly to non-statutory subject matter.

With respect to claim 8, the Examiner argues that claim recites "a program for causing a computer to execute...", this is merely software, and it has been held that software without a required computer-readable medium storing the software that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive material and non-statutory under 35 U.S.C. 101.

#### **The Claimed Invention Recites A Process Of Providing Appropriate Service By A Computer to A User of An Initial and A Repeated Use Of A Product.**

MPEP 2106.01, cited by the Examiner, which states in the relevant part that "the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program". (Emphasis added).

Applicant recites, in claim 8, "a method for ... judging whether the product is presented by the user upon purchase of the commodity or service ... providing the product having a writable storage medium attached thereto and writing information

as to initial use in the attached writable storage medium... judging whether a writable storage medium is attached to the product... attaching a writable storage medium to the product presented upon purchase of the commodity or service and writing information as to initial use in the attached writable storage medium...reading storage information from the writable storage medium which is attached to the product, when the user presented the product with the writable storage medium attached thereto". The method further includes a step of "recognizing the use history of the product from the storage information acquired". The method further includes a step of "judging the service content by checking the use history recognized in a table where service content is defined according to the number of repeated uses of the product". The method further includes a step of "executing a processing according to the service content judged and outputting the processing result to an output apparatus". The method finally includes a step of "writing information as to reuse in the writable storage medium that the process corresponding to the executed service content has been performed by the step of executing". Thus, the steps of "judging", "providing", "attaching", "reading", "recognizing", "executing" and "writing" clearly constitutes a series of steps or acts to be a process. Applicant's claims recite a computer implemented process of providing an appropriate service by a computer to a user of an initial and a repeated use of the product, and thus recite statutory subject matter. Furthermore, claim 9 has been canceled and claim 8 has been amended to include feature of claim 9 such as "storage medium embodying program". This amendment of claim 8 makes a content of claim 8 even a further statutory matter. Accordingly, claim 8 is in compliance with 35 USC 101.

**Rejections under 35 U.S.C. 102 (b)**

As to the rejection of claims 1-16 under 35 USC 102 (b) as anticipated by Nagata (US 2002/0077979), such rejection is traversed insofar as it is applicable to the present claims, and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, the reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by person of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Applicant notes that by the present amendment, independent claims 1, 7, 8, and 10 have been amended to clarify features of the present invention in light of the comments by the Examiner. Independent claim 1 (taken as an example) has been amended to recite (in relevant part): "... a step of first judging whether the product is presented by the user upon purchase of the commodity or service; wherein when the step of first judging judges that no product is presented by the product user upon

purchase of the commodity or service, a step of providing the product having a writable storage medium attached thereto and writing information as to initial use in the attached writable storage medium; wherein when the step of first judging judges that the product is presented by the user, a step of second judging judges whether a writable storage medium is attached to the product; wherein when the step of second judging judges that the product has no writable storage medium attached thereto, a step of attaching a writable storage medium to the product presented upon purchase of the commodity or service and writing information as to initial use in the attached writable storage medium” (emphasis added). Independent claims 7, 8, and 10 have been amended to recite similar features; and such features are described for example, in lines 14-27, on page 14, in lines 1-10, on page 15 of the specification and illustrated in FIG. 3.

Applicant notes that it is an object of present invention is to easily promote repeated use of a product and provide a service according to it. However in order to achieve the aforementioned object the sale staff needs to provide the consumer with the product first. For example, when the consumer 300 requests to buy the beverage as a commodity at the sales store (s1001 in FIG. 3), the reader/writer device 220 recognizes whether the consumer 300 has brought a commodity vessel (s1002 in FIG. 3). This recognition processing may be performed by receiving input from the sales staff or detected by a sensor or the like. When it is recognized that the consumer has not brought any commodity vessel, a chip-equipped vessel 210 is provided to the consumer 300 (s1005 in FIG. 3). This providing process is performed by the reader/writer device 220 which issues an instruction to a mechanism providing the chip-equipped vessel 210 or outputs an instruction via an output section to the sales staff 200 to provide the chip-equipped vessel 210. Once the consumer provided with the chip-equipped vessel 210 the initial use information is written into the non-contact IC chip 312 attached to the commodity vessel 311 via the reader/writer section 240.

On the other hand, when it is recognized that the consumer has brought a commodity vessel, it is judged whether the vessel is a chip-equipped vessel 310 or a commodity vessel 311 having no non-contact IC chip (s1003 in FIG. 3). This processing can be performed by the read operation of the reader/writer section 240 of the reader/writer device 220 which detects presence/absence of the non-contact IC chip. Here, if it is judged that no non-contact IC chip is attached, a non-contact IC chip is attached to the commodity vessel brought by the consumer 300 (s1004 in FIG. 3). Thus, due to the judgment process disclosed above, the commodity vessel presented by the consumer 300 to the sales staff for reuse is always a chip-equipped vessel 310.

Applicant submits that aforementioned features of the independent claims are not disclosed or taught in the cited art, as will become clear from the following discussion.

Irrespective of the contentions by the Examiner concerning the disclosure of Nagata, Nagata discloses in FIGS. 33, 9(a) and 10(a) that the service provider 10 collects data on all the toner cartridges 60 that are to be delivered to the contract signer 1 and stores the data in the terminal station 12 of the service provider 10 immediately or later. The data is collected by attaching a data storage body (second data storage body) 7 storing data (unique data on the product-in-circulation) to distinguish each toner cartridge 60 from the others to packing material 63 of the product-in-circulation 6 as and reading the data in a data carrying section 73 of the data storage body 7 for the data by means of a scanner when the product-in-circulation is delivered to the contract signer 1. Having collected the data, the service person pulls off the data storage body 7 to confirm that the data has been read. By thus forming the data storage body 7 so that it can be detached from the product-in-circulation 6, one can tell based on the presence or absence of the data storage body 7 whether the product has been delivered or not. However, at no point at the above-described process in Nagata, the service provider 10 has to make a

judgment call whether the product-in-circulation 6 (cartridge) is installed (present) in the image forming apparatus 2. In Nagata, the sensor circuit 9 detects whether the toner cartridge 60 is installed in the image forming apparatus 2 on the contract signer side 1. Furthermore, at no point in Nagata, the contract signer 1 presents to the service provider 10 the product-in-circulation 6 without the data storage body 7, where the service provider 10 has to attach the data storage body 7 to the product-in-circulation 6, as recited in the independent claims of the application. In Nagata, the service person on the contract signer 1 always receives the cartridge with attached storage body. Thus, in Nagata the service provider 10 does not have to make the same or even similar judgment calls as a sales staff 200 in the present invention. Thus, Nagata fails to disclose or teach: "...a step of first judging whether the product is presented by the user upon purchase of the commodity or service; wherein when the step of first judging judges that no product is presented by the product user upon purchase of the commodity or service, a step of providing the product having a writable storage medium attached thereto and writing information as to initial use in the attached writable storage medium; wherein when the step of first judging judges that the product is presented by the user, a step of second judging judges whether a writable storage medium is attached to the product; wherein when the step of second judging judges that the product has no writable storage medium attached thereto, a step of attaching a writable storage medium to the product presented upon purchase of the commodity or service and writing information as to initial use in the attached writable storage medium" (emphasis added), as recited in the independent claims of the application. Accordingly, applicant submits that the independent claims and the dependent claims patentably distinguish over Nagata and should be considered allowable thereof.

With respect to the dependent claims, applicant note that such claims also recite further features not disclosed or taught in the cited art. For example, with respect to new dependent claims 14 and 15, Nagata fails to disclose "... a table to be

used at the step of judging the service content is stored at the location other than the writable storage medium". Support for the claim language can be found, for example, lines 5-10, page 11 of the specification and in FIG. 5. As an incentive, various services as shown in Table 500 in FIG. 5 are provided in the present invention. Further, the "non-contact IC chip" is used as the "storage medium". As compared with an "IC card" as disclosed in Nagata, a "non-contact IC chip" has a limited storage capacity. Thus, it is desirable to reduce an amount of data to be stored in the "non-contact IC chip" as small as possible. Thus, in the present invention, the table 500 is stored in location other than writable storage medium.

With such an arrangement, it is possible to use a "non-contact IC chip" having a relatively small storage capacity in the present invention. Further, where the Table 500 is provided on the reader/writer section side, it is easier to modify a relationship between times of usage (usage frequency) and an incentive (service) such as in a case of modifying an incentive from one-cent cash-back bonus per usage of a product to two-cent cash-back bonus per usage.

In view of the above amendments and remarks, applicant submits that all claims present in this application should now be in condition for allowance and issuance of an action of favorable nature is courteously solicited.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of either by telephone discussion or by personal interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus,

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LLP Deposit Account No. 01-2135 (Docket No. 500.43340X00), and please credit any excess fees to such Deposit Account.

Respectfully submitted,  
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